

REMARKS

Reconsideration of the rejections set forth in the Final Office Action mailed April 11, 2005, is respectfully requested. Claim 21 has been amended. Claims 12-38 remain pending in this case. Specification support for these amendments can be found at, e.g., examples 41-45, 49, 52, 53, 61-62, and 64, and associated text. Therefore, these amendments are made without introducing new matter.

35 U.S.C. § 132

The amendment filed on February 28, 2005, is objected to under 35 U.S.C. § 132 for allegedly introducing new matter into the disclosure. In particular, the examiner has taken the position that the terminology “Dowex™ polymeric sulfonic acid H⁺” (paragraphs 0290, 0298, and 0470), “1-bromo-3-fluoro-propane” (paragraph 0459), “3-bromo-1,1,1-trifluoro-propane” (paragraph 0463), “white solid” (paragraph 0283), and “dropwise” (paragraph 0476) were not disclosed or suggested by the specification as originally filed.

With respect to “Dowex™ polymeric sulfonic acid H⁺,” applicants have deleted this phrase from paragraphs 0290, 0298, and 0470.

With respect to “1-bromo-3-fluoro-propane” in paragraph 0459, applicants respectfully assert that no new matter was added with this amendment. “1-bromo-3-fluoro-propane” was added to paragraph 0459 to replace “3-fluoropropyl bromide” as the alkylating agent. Applicants respectfully assert that both of these chemical names refer to the same chemical structure depicted below.



With respect to “3-bromo-1,1,1-trifluoro-propane” in paragraph 0463, applicants have deleted this phrase from paragraph 0463.

With respect to “white solid” in paragraph 0283, applicants respectfully direct the examiner’s attention to paragraph 0283 as originally filed, which states that “the reaction mixture was concentrated and purified by chromatography to give a white solid.” (lines 5-6, emphasis added) Therefore, applicants respectfully assert that the addition of “the title compound as a white solid” is not new matter.

With respect to “dropwise” in paragraph 0476, applicants have deleted this term from paragraph 0476.

Therefore, applicants respectfully request withdrawal of the objections and reconsideration of the specification as amended.

35 U.S.C. § 112

Claim 21 was rejected under 35 U.S.C. § 112, first paragraph. In particular, the examiner has taken the position that the specification does not reasonably provide enablement for the terms “substituted alkyl” or “substituted alkoxy.” Applicants have replaced these terms with the groups “halogenated alkyl” and “halogenated alkoxy,” respectively. Support for these amendments can be found in, e.g., examples 41-45, 49, 52, 53, 61-62, and 64, and associated text. Therefore, applicants respectfully request withdrawal of these rejections.

Patent
Attorney Docket: 892,280-602
(formerly 342312004900)

Double Patenting

Claims 12-38 were provisionally rejected under the judicially created obviousness-type double patenting as being allegedly unpatentable over claims 1-23 of co-pending application no. 10/777,455. Applicants note that the '455 application is not yet allowed or issued. Therefore, Applicants will address this rejection upon an indication of allowance in the other case.

Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact the applicants' undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any fees that may be required in connection with the filing of these documents to Deposit Account No. 50-2862.

Respectfully submitted,

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